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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,664	02/06/2002	Chuan Li	ETLPMU 011502	8973
Chuan Li Apt. 158 7908 Avenida Navidad San Diego, CA 92122			EXAMINER KETTER, JAMES S	
			ART UNIT 1636	PAPER NUMBER
			MAIL DATE 04/02/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/068,664

Applicant(s)

LI, CHUAN

Examiner

James S. Ketter

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-15 and 26-40 is/are pending in the application.
- 4a) Of the above claim(s) 6-15 and 31-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 1-15 and 31-40 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 10 October 2006.

The indication of allowability of the elected claims in the Office Actions mailed 20 April 2007 and 20 May 2008 is hereby withdrawn. New grounds of rejection are presented below. The delay in setting forth the rejections below is regretted.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that the specification does not discuss the synthesis or SEQ ID NO:37 or set forth its components. It is not clear if the plasmid is described at all in the specification, and therefore if it has a patentable function. As such, no link has been established between the claimed sequence and any components or functions of any plasmid. Furthermore, no data demonstrating any function of the claimed plasmid has been presented. One of skill in the art,

therefore, would not have recognized that Applicants was in possession of the claimed invention, and as such the claimed invention lacks adequate written description.

Claims 26-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The following factors have been considered in the rejection:

The nature of the invention. The claimed invention is drawn to SEQ ID NO:37 comprised by a plasmid.

The amount of direction or guidance presented in the specification, and the presence or absence of working examples. The specification does not discuss any components or functions of the claimed plasmid. It does not appear that any information about the plasmid or its manner of usage or mode of operation is set forth. No exemplification of the use of this plasmid is presented.

The state of the prior art, and the predictability or unpredictability of the art. The art did not teach as of the time of filing, a way of determining a priori, i.e., predicting, what is the function of any particular polypeptide merely from the primary sequence or the nucleotide sequence encoding it. Thus, the function of a plasmid could not have been predicted either.

Conclusion. Were the skilled practitioner in the art to have attempted to use the claimed plasmid, said practitioner first would have turned to the specification for guidance as to the

features of the plasmid and its mode of operation. However, as set forth above, the specification did not set forth a discussion of any features or operation of SEQ ID NO:37. Next, said practitioner would have turned to the prior art for such guidance. However, again, for reasons set forth above, the prior art would not have provided such information, or a way of predicting such information, i.e., the art was unpredictable. Finally, the skilled practitioner would have been forced to turn to empirical experimentation to determine how to use the claimed plasmid. However, experimentation in an unpredictable art, without sufficient guidance, to determine the functional properties of a plasmid, would have been deemed undue experimentation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James S. Ketter whose telephone number is 571-272-0770. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JSK
2 April 2009

/James S. Ketter/
Primary Examiner, Art Unit 1636